

### **REMARKS**

Claims 1-28 are pending in the present application. By this response, claims 1, 11, 12, 15, 16, 22, 23, and 27 are amended and claims 17 and 25 are canceled. Claims 1 and 27 are amended to clarify the subject matter which is being claimed. Support for these amendments may be found at least on page 10, line 23 to page 11, line 2 of the present specification. Claims 11, 12, and 15 are amended in view of the amendments to claim 1. Claim 16 is amended to incorporate subject matter previously recited in claim 17. Claim 22 is amended in view of the amendments to claim 16. Claim 23 is amended to incorporate subject matter previously recited in claim 25. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

#### **I. Allowable Subject Matter**

Applicants thank Examiner Neyzari for indicating that the subject matter of claims 17 and 25 is allowable. By this Response, Applicants amend independent claims 16 and 23 to include the allowable subject matter of claims 17 and 25 as indicated by the Examiner. Claims 18-22, 24, and 26 are dependent on independent claims 16 and 23 and, thus, are allowable by virtue of their dependency on independent claims 16 and 23.

#### **II. 35 U.S.C. § 102, Alleged Anticipation, Claims**

The Office Action rejects claims 1-16, 18-24 and 26-28 under 35 U.S.C. § 102(b) as being anticipated by Fisher et al. (U.S. Patent No. 5,870,732). This rejection is respectfully traversed.

Claims 16, 18-24 and 26 have been addressed above.

As to claims 1 the Office Action states:

Fisher et al disclose an automated virtual storage and retrieval library, a method for creating a new inventory of physical media volumes (cartridge) and the related logical volumes stored on the physical media. The method exports the existing logical volume records from a stored

table to file via a data base computer program into a new table, operates the library accessor to scan all the library cells to read the label of all cartridges in the cells.

Office Action dated March 24, 2005, pages 2-3.

Claim 1 reads as follows:

1. A method of configuring a robotic storage media library, the method comprising:
  - determining a number of columns of drives in the robotic storage media library;
  - determining a number of drives in each column in the robotic storage media library;
  - automatically retrieving hardware characteristics from a hardware component associated with the robotic storage media library; and
  - configuring the robotic storage media library based upon the hardware characteristics, the number of columns of drives, or the number of drives in each column.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Fisher does not teach every element of the claimed invention arranged as they are in the claims. Specifically, Fisher does not teach determining a number of columns of drives in the robotic storage media library; determining a number of drives in each column in the robotic storage media library; and configuring the robotic storage media library based upon the hardware characteristics, the number of columns of drives and the number of drives in each column.

Fisher is directed to an automated virtual storage and retrieval library. Fisher teaches a method for creating a new inventory of physical media volumes (cartridges) and of related logical volumes stored on the physical media. Fisher exports the existing logical volume records from a stored table to a file via a data base program, deletes the

existing physical and logical volume records from the table, and then imports the logical volume records from the file via the data base program into a new table. The library accessor scans all the library cells to read the labels of all the physical media volumes (cartridges) in the cells, inserts physical volume records into the stored table, and indicates to a host that the library is online.

Thus, Fisher creates a new inventory of the cartridges and the related logical volumes stored on the physical media. Fisher teaches using the existing logical volume records to create the new cartridge table. Upon starting the reinventory process, Fisher searches the cartridge table for each record to select the "logical" type volumes. Fisher then deletes all non-selected records. All remaining records (the selected "logical" type volumes) in the cartridge table and, optionally, the associated indexes are exported to a binary file via a data base program of the library manager. After the selected records have been exported to the file via the data base program, the cartridge table is erased. The erasure will make all the space available for the new table. There will be no more dead space that otherwise would need to be cleaned up and reorganized. Fisher then inserts records into the new cartridge table. The records that had been exported to the binary file via the data base program (logical volume records) are now imported and loaded into the new cartridge table. Fisher's library manager then operates to cause a bar code scanner to scan every cell in the library and read every identifying cartridge label. Racks are scanned one rack at a time, one side of the aisle at a time, in a serpentine pattern.

Thus, Fisher uses an existing cartridge table to repopulate its inventory. Fisher does not take into account that the robotic storage media library may change in physical capacity. The present invention determines a number of columns of drives in the robotic storage media library and determining a number of drives in each column in the robotic storage media library. Thus the present invention would be a precursor to the Fisher invention and would improve the operation of the Fisher invention.

Independent claim 27 recites similar subject matter to that of independent claim 1. Claim 27 recites "the robotic manipulator determines a number of columns of drives in the robotic storage media library and the robotic manipulator determines a number of drives in each column in the robotic storage media library."

Thus, Fisher does not teach each and every feature of independent claims 1 and 27 as is required under 35 U.S.C. § 102. At least by virtue of their dependency on independent claims 1 and 27, the specific features of dependent claims 2-15 and 28 are not taught by Fisher. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-15 and 28 under 35 U.S.C. § 102.

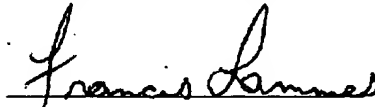
Furthermore, Fisher does not teach, suggest or give any incentive to make the needed changes to reach the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Fisher such that a determination is made of the number of columns of drives in the robotic storage media library and a determination is made of the number of drives in each column in the robotic storage media library, one of ordinary skill in the art would not be led to modify Fisher to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Fisher in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

### III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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